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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/773,346

02/09/2004

John C. Jaeger

21375

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06/24/2008

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EXAMINER

RAMANA, ANURADHA

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

06/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/773,346

Applicant(s)

JAEGER, JOHN C.

Examiner

Anu Ramana

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2008.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-17, 22-28 and 30-32 is/are rejected.
- 7) ☒ Claim(s) 11-13 and 18-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 20, 2008 has been entered.

### ***Claim Objections***

Claims 8 and 9 are objected to because of the following informalities. Applicant interchangeably uses the terms "biasing means" and "means operatively interconnecting said support frame and said blade for yieldingly biasing said....." The Examiner reiterates that proper means-plus-function language must be used if Applicant is trying to invoke 112 sixth paragraph. Further, consistent terminology must be used to avoid confusion. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-10, 15-17, 23, 26, 28, 30, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhu et al. (US 5,293,863).

Zhu et al. disclose an instrument insertable into a body cavity including: a rigid internal support frame 70; three blades (72, 74, 76) circumferentially spaced relative to

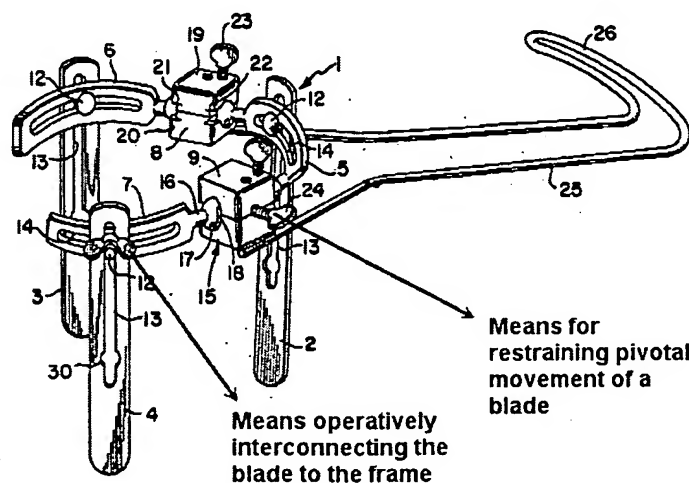
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the centerline and pivotally interconnected to the frame; each of the blades being provided with a spring (100) or "means operatively interconnecting the support frame and the blade for yieldingly biasing the blade into engagement with the elongated sections of the other blades; and each of the blades being provided with a means for restraining pivotal movement thereof at selected angles, i.e., a threaded shaft attached to a knob (Figs. 13-14, col. 12, lines 17-68 and col. 13, lines 1-26).

Claims 1-2, 4-5, 8, 10, 15-17, 23, 26 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Karlin et al. (US 3,509,873).

Karlin et al. disclose a retractor including: a support frame (defined by support members 5, 6, 7); at least three blades (2, 3, 4); means operatively connecting each blade to the frame; and means for restraining the pivotal movement of a blade (Fig. 1, col. 2, lines 55-72, cols. 3-4 and col. 5, lines 1-53). See marked up Fig. 1 from Karlin et al. below.

Regarding claim 10, Karlin et al. disclose a plurality of blocks 8 and 9, each of which interact with a respective end section of a respective blade by means of members 5, 6 and 7.



Claims 1-6, 10, 15-17, 22-27, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Charters (US 5,916,151).

Charters discloses an instrument for dilating a body cavity including: a control ring or "support frame" 31; at least three blades 11; means operatively interconnecting the support frame and the blade, i.e., 50, for yieldingly biasing the elongated section of a blade into engagement with the elongated section of another blade; and means for restraining pivotal movement thereof at selected angles (55) (Figs. 3, 5, 7 and 9, cols. 3-4 and col. 5, lines 1-19).

Note, during examination, claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Thus, "blade" is being interpreted to be a "long, thin piece" (Source: The American Heritage® Dictionary of the English Language: Fourth Edition. 2000).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charters (US 5,916,151).

Charters discloses the claimed invention except for the claimed shape of the support frame. It would have been an obvious matter of design choice to one of ordinary skill in the art at the time the invention was made to have constructed the support frame with an octagonal shape, since applicant has not disclosed that this solves any stated problem or is anything more than one of numerous shapes or

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configurations a person of ordinary skill in the art would find obvious for the purpose of providing a support frame. In re Dailey and Eilers, 149 USPQ 47 (1966).

Claims 3, 14, 22, 24, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhu et al. (US 5,293,863).

Zhu et al. disclose the claimed invention except for the claimed shape of the blade end sections and the claimed shape of the support frame. It would have been an obvious matter of design choice to one of ordinary skill in the art at the time the invention was made to have constructed the Zhu et al. blades with end sections that are rounded so that the end sections form a hemisphere when the blades are in a closed position or to provide the support frame with an octagonal shape, since applicant has not disclosed that this solves any stated problem or is anything more than one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of providing a blade or a support frame. In re Dailey and Eilers, 149 USPQ 47 (1966).

### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on March 20, 2008 have been fully considered.

Applicant's arguments with respect to the rejections of claims 1-2, 4-5, 8, 10, 15-17, 23, 26 and 31 as being anticipated by Karlin et al. are not persuasive because Karlin et al. disclose all elements of Applicant's claimed invention.

The Examiner notes that "pivotally connected" only requires the blades to have the capability to pivot or angulate with respect to the arcuate members 5, 6 and 7 defining the support frame. When the wing nuts are not completely tightened, the blades angulate with respect to the frame and are therefore pivotally connected to the frame. Also, when the wing nuts are not completely tightened, the blades are capable of moving into engagement with one another (see Fig. 2).

Applicant's arguments with respect to the rejections of claims 1-6, 10, 15-17, 22-27 and 31 as being anticipated by Charters are not persuasive for the following reason. As described in the rejection in this office action, Charters clearly discloses a tensioning device 50 "operatively interconnecting the blades and the annular member 31." Tensioning device 50 is being interpreted to be the "means for yieldingly biasing the elongated section of a blade into engagement with other blades (see Figs. 1-3 and col. 3, lines 42-58).

#### ***Allowable Subject Matter***

The indicated allowability of claims 9 and 30 is withdrawn in view of the new rejections made in this action. The Examiner sincerely apologizes for any inconvenience caused to the Applicant by this action.

Claims 11-13 and 18-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
June 23, 2008

/Anu Ramana/  
Primary Examiner, Art Unit 3733